

Application No. 10/660,379

Response to Restriction Requirement

Restriction Requirement

The Office Action sets forth a two-way restriction requirement which identifies two allegedly distinct inventions. In particular, the Office Action asserts that the invention of Group I (i.e., claims 1-42), which is directed to a composition for polishing semiconductor wafers, is patentably distinct from the invention of Group II (i.e., claims 43-98), which is directed to a method for polishing a semiconductor substrate.

The Office Action further requires restriction between allegedly patentably distinct species. In particular, the Office Action requires restriction between a first species comprising an inorganic acid oxidizer and a second species comprising an organic acid oxidizer.

Applicants' Election

Applicants elect, with traverse, the invention of Group I. Applicants further elect, with traverse, a chemical-mechanical polishing composition comprising an organic acid selected from the group consisting of oxalic acid, malic acid, malonic acid, tartaric acid, acetic acid, lactic acid, propionic acid, phthalic acid, benzoic acid, citric acid, succinic acid, salts thereof and combinations thereof, for the purposes of examination. Claims 8-10, 20, 29-31, 42, 51-53, 63, 73-75, and 86 encompass the aforesaid polishing composition.

Request for Withdrawal of Restriction Requirement

Applicants respectfully request that the restriction requirement be withdrawn and that the claims of Group II be examined with the claims of Group I for the reasons set forth below.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the examiner if restriction is not required. Consequently, as set forth in M.P.E.P. § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*” (emphasis added). As such, both of these criteria must be met for a restriction requirement to be proper.

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In support of the restriction requirement, the Office Action states that, generally, process and product claims belong to independent classes, and alleges that, in the present case, the product as claimed can be used in a materially different process such as one in which no substrate is chemically-mechanically polished. However, the Office Action has failed to allege that examination of both groups of claims would present any serious burden on the Examiner and, therefore, has failed to meet both of the criteria necessary for a proper restriction requirement. Indeed, the fact that the Patent Office has already issued four Office Actions in connection with examination of the present application on the merits is *prima facie* evidence that examination of both groups of claims has not heretofore presented any serious burden on the Examiner.

Further, it does not appear that examination of all of the claims at the same time would present a serious burden on the Examiner inasmuch as the pending claims pertain to substantially overlapping subject matter. In particular, the claims of both Groups I and II reference a composition comprising fumed silica particles, at least one alkaline earth metal selected from a particular group, an oxidizing agent, and water. Applicants respectfully submit that this significant overlap in subject matter would allow, and has appeared to allow up to the present time, for concurrent examination of the inventions of Groups I and II without a serious burden. Additionally, the nature of the claims is such that references cited against the claims of Group I would likely be cited against the claims of Group II. This does not mean that the claims necessarily stand and fall together, but the potential for overlap of relevant references is further evidence of the absence of a serious burden being placed on the Examiner to examine both groups of claims together. Indeed, in each of the four Office Actions issued in connection with examination of the present application, the cited references were applied in rejections of the inventions of Groups I and II, and in no instance was a reference applied against the invention of only Group I or II.

In view of the foregoing, Applicants respectfully request the withdrawal of the restriction requirement and consideration of the pending claims of Group II (i.e., claims 43-98) in addition to those of Group I (i.e., claims 1-42).

Response for Withdrawal of Species Selection Requirement

Applicants note that, if and when a generic claim embracing the elected species is allowed, the nonelected species, if included in dependent claims incorporating all of the

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limitations of the generic claim, will no longer be withdrawn from consideration since they also would be fully embraced by the generic claim. See M.P.E.P. § 809.02(a). In any event, however, Applicants respectfully submit that the species selection requirement is improper for the reasons set forth herein and, therefore, request withdrawal of the species selection requirement.

The polishing compositions encompassed by the pending claims are sufficiently similar that there will be no serious burden on the Examiner to search and examine all of the subject matter defined by the pending claims at the same time. The claims directed to the two species all reference a composition comprising fumed silica particles, at least one alkaline earth metal selected from a particular group, an oxidizing agent, and water. In addition, the claimed subject matter was the subject of three separate searches conducted by the Examiner with respect to the present application. While Applicants agree that the subject matter encompassed by the pending claims should, and indeed must, be fully searched, Applicants believe that the earlier three searches of record demonstrate that the outstanding restriction requirement between species is not necessary to fully and effectively conduct a further search and continue examination as to all of the claimed subject matter.

In view of the foregoing remarks, Applicants respectfully request withdrawal of (a) the restriction requirement between Group I (i.e., claims 1-42), and Group II (i.e., claims 43-98), and (b) the restriction requirement between species comprising an organic acid (i.e., claims 8-10, 20, 29-31, 42, 51-53, 63, 73-75, and 86) and species comprising an inorganic acid (i.e., claims 7, 19, 28, 41, 50, 62, 72, and 85). If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


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